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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,159

12/15/2003

Ilan Twig

TWIG1A

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7590

07/05/2006

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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,159

Applicant(s)

TWIG ET AL.

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/15/03.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the preliminary amendment filed on March 14, 2006. Claims 1-2 have been canceled, claims 3-24 are pending for examination.

Priority

Applicant's claim for the benefit of a prior-filed application No. 09/855,751 filed on May 16, 2001, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Specification

The disclosure is objected to because of the following informalities:

The attempt to incorporate subject matter into this application by reference to U.S. Application No. 09/855,751 is ineffective, because the patent No. is missing for this application and it should be updated to reflect the actual status.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 2161

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,665,676. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Because claim 17 of U.S. Patent No. '676 contains every element of claim 1 of the instant application via same intended details and thus anticipates the claim of instant application. Claim 1 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3 - 24, are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

As to claims 3 and 19, these claims merely execute a software application to present abstract data or image without using any tangible or physical device, hence, the claims direct to non-statutory subject matter.

As to claim 24, this claim merely presents search results on a client machine, it fails to produce a concrete and useful result, therefore, it directs to non-statutory subject matter.

As to claims 4-19 and 20-23, these claims have the same defects as their base claims respectively, thus, are rejected for the same reason.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 3-23, the claim language extensively uses the term "wherein" but the instant specification fails to provide actual steps to perform or limit these claims to a particular structure, thus, this term renders the claimed scope to be indistinct. See In re

Markman v. Westview Instruments, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), off 'd, U.S., 116 Ct. 1384 (1996).

As to claims 6, 15 and 21, the use of the phrase --and/or -- renders these claims indefinite, since this phrase leads to more than one interpretations of the claimed limitations, In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-24, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2005/0165766 A1 issued to Szabo.

Claim 3:

Szabo discloses a system for presenting results of a search query pertaining to commercial enterprises [e.g., Abstract], the system comprising a server executing a software application being designed for:

(a) receiving from a user client networked to said server a search request [e.g., sections: 0091- 0095]; and

(b) providing said user client with data pertaining to a plurality of commercial enterprises matching said search request such that said user of said user client is presented with an image including said plurality of commercial enterprises superimposed over map data, wherein a level of visibility of each commercial enterprise of said plurality of commercial enterprises in said image is determined according to at least one selection criteria provided by a user of said user client or by said server [e.g., sections: 0099-0102, Fig. 1A].

Claim 4:

Szabo further discloses that said map data is provided by said server along with said data pertaining to a plurality of commercial enterprises [e.g., sections: 0095 –0098].

Claim 5:

Except the limitations recited in claim 3, Szabo further discloses that said map data is stored by said user client and said data pertaining to a plurality of commercial enterprises includes information for superimposing each of said plurality of commercial enterprises over said map data [e.g., sections: the downloadable applet technique at 0099-0100].

Claim 6:

Except the limitations recited in claim 3, Szabo further discloses that said plurality of commercial enterprises include businesses and/or advertised content [e.g., section: 0098].

Claim 7:

Except the limitations recited in claim 3, Szabo further discloses that said at least one selection criteria forms a part of a user-specific profile [e.g., section: 0019].

Claim 8:

Except the limitations recited in claim 3, Szabo further discloses that said user-specific profile is generated by said server according to information provided from said user client [e.g., section: 0180].

Claim 9:

Except the limitations recited in claim 3, Szabo further discloses that said image further displays commercial enterprise-related information for each of said plurality of commercial enterprises matching said search request [e.g., section: 0020, Fig. 1A].

Claim 10:

Except the limitations recited in claim 9, Szabo further discloses that said commercial enterprises-related information is provided to said user by said server as various layer of information [e.g., section: 0102, Fig(s). 1A-1E].

Claim 11:

Except the limitations recited in claim 3, Szabo further discloses that said server is further capable of providing said user with information relating to a group of commercial enterprises [e.g., sections: 0105-0106, Fig(s). 1A-1E].

Claim 12:

Except the limitations recited in claim 3, Szabo further discloses that said server is also capable of managing an affiliation of said user to consumer clubs associated with at least one commercial enterprise of said plurality of commercial enterprises [e.g., the right management processing at section 0157].

Claim 13:

Except the limitations recited in claim 3, Szabo further discloses that each of said plurality of commercial enterprises is capable of periodically providing said server with information relating thereto [e.g., sections: 0136-0138].

Claim 14:

Except the limitations recited in claim 3, Szabo further discloses that said selection criteria is relevancy of each of said plurality of commercial enterprises to said search request [e.g., section: 0010].

Art Unit: 2161

Claim 15:

Except the limitations recited in claim 3, Szabo further discloses that said level of visibility is a function of a graphical display size, color of each of said plurality of commercial enterprises [e.g., section: 0201, Fig(s) 1A-1E] .

Claim 16:

Except the limitations recited in claim 3, Szabo further discloses that said server is capable of enabling bidirectional communication between said user client and each of said plurality of commercial enterprises [e.g., the use of Internet protocols at sections: 0006-0008].

Claim 17:

Except the limitations recited in claim 3, Szabo further discloses that at least one selection criteria provided by said server is a subscription fee paid by each of said plurality of commercial enterprises [e.g., sections: 0130-0131].

Claim 18:

Except the limitations recited in claim 10, Szabo further discloses that said commercial enterprise-related information is updated dynamically by said server [e.g., sections: 0173-0174].

Claim 19:

Szabo discloses a system for presenting results of a search query pertaining to commercial enterprises [e.g., Abstract], the system comprising a server executing a software application being designed for:

(a) receiving from a user client networked to said server a search request [e.g., sections: 0091- 0095]; and

(b) providing said user client with an image displaying a plurality of commercial enterprises matching said search request, wherein a level of visibility of each commercial enterprise of said plurality of commercial enterprises in said image is determined according to at least one selection criteria provided by a user of said user client or by said server [e.g., sections: 0099-0102, Fig. 1A].

Claim 20:

Except the limitations recited in claim 19, Szabo further discloses that said at least one selection criteria provided by said user is geographical location [e.g., the Site Mapping[™] at section: 0243].

Claim 21:

Except the limitations recited in claim 19, this claim recites similar subject matters as claim 15, hence are rejected along the same rational.

Claim 22:

Except the limitations recited in claim 19, Szabo further discloses that each of said plurality of commercial enterprises matching said search request is positioned in said image according to its respective location on a map [e.g., sections: 0234-0246] .

Claim 23:

Except the limitations recited in claim 19, this claim recites similar subject matters as claim 9, hence are rejected along the same rational.

Claim 24:

Szabo discloses the claimed method of presenting search results of at least one specified category of commercial enterprise on a client machine, comprising displaying on a display of the client machine a map and showing on said map respective locations of commercial enterprises of said at least one specified category within an area covered by said map [e.g., Abstract, sections: 0091-0102, Fig(s). 1A-1E].

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Dedrick (U.S. Patent No. 5,724,521) which discloses a system for providing electronic advertisements to end users in a consumer best-fit pricing manner.

b) Szabo (U.S. Patent No. 6,868,525) which discloses an improved computer graphic display system using collaborative filter to define appropriate associated objects.

c) Kaddeche et al. (U.S. Patent Publication No. 2002/0046104 A1) which discloses a method and apparatus for generating targeted impressions to internet clients.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

June 16, 2006 